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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,599	10/29/2003	Gonzalo E. Labarca	CE11909JME	6879

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EXAMINER

LARSON, JUSTIN MATTHEW

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/696,599	LABARCA ET AL.	
	Examiner	Art Unit	
	Justin M. Larson	3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/29/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 10/29/03 is noted. The submission is in compliance with the provisions of 37 CFR 1.97 and 1.98. Accordingly, the examiner is considering the information disclosure statement.

Drawings

2. The drawings are objected to because:

- A. Figure 3 does not show the central cavity being spherical, as recited in claims 4 and 6 and better shown in Figures 4 and 5. As shown below, walls A project straight down from flat, upper surface B, indicating that the cavity is cylindrical in shape, not spherical. There would be some curvature to walls A if the cavity were in fact spherical.

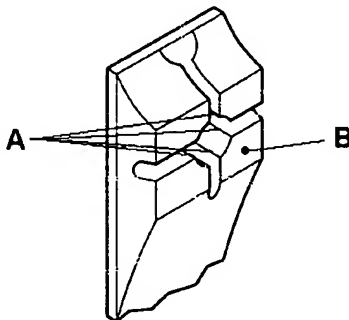


FIG. 3

- B. Figures 3 and 4 both show an opening (304) whose height is the limiting factor as to just how big of a spherical-ended swivel member can be inserted into the opening. In both figures, the height of opening (304) is shown to be smaller than the diameter of the central cavity (306)'s upper

opening. This would mean that a spherical-ended swivel member whose spherical end was small enough to fit into opening (304) would have a spherical end of a diameter smaller than the central cavity's upper opening, allowing the swivel member to be easily pulled right out of the upper opening, defeating the purpose of the invention.

- C. Figure 5 does not correspond to either of the top views of Figures 3 or 4. Notice that Figure 5 shows an opening shaped like roughly $\frac{3}{4}$ of a cylinder while Figures 3 and 4 each show an opening shaped like roughly $\frac{1}{2}$ of a cylinder.

3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. No new matter should be entered. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of

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any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claim 17 is objected to because of the following informalities: At the end of line two, the word channel should be plural, "channels". Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 11-17, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "the first swivel member's cavity" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claims 12-17 are rejected for including the subject matter of claim 11.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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8. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Johnson (US 2005/0115999 A1). Johnson discloses an electronic device carrying system, comprising: a belt clip member having a central opening having at least one radiating channel (Figure 1J); a swivel base member having a central opening having at least one radiating channel (Figures 7A-7B); and a swivel member (460, Figures 7A-7B) coupled between the belt clip member and the swivel member.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2, 3, 11, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Williams, Jr. (US 6,793,108).

Regarding claim 2, Johnson discloses the claimed invention including a two-ended swivel member, one end being spherical, but fails to disclose the other end being spherical as well. Johnson's swivel member (460, Figure 6A) is by design intended to rotate only 180 degrees along a single axis ([0248]), however, Johnson discloses that in another embodiment, although not shown, the pin may be designed so as to allow a full 360 degree rotation.

Now, Williams, Jr. discloses a pivoting assembly where a swivel member (312) connects two base members (350 & 130) and teaches that forming both ends of the swivel member with a spherical shape and mounting them in spherical cavities allows

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for a 360 degree rotation of the swivel member with respect to each base member (Figure 9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a spherical end on the second end of the swivel member of Johnson, in addition to the first, and to mount that spherical end in a spherical cavity, as taught by Williams, Jr., in order to allow the swivel member to rotate 360 degrees with respect to each the swivel base member, providing a user with a greater degree of freedom when using the swivel clip.

Regarding claim 3, Johnson in view of Williams, Jr. discloses the claimed invention except for the first spherical end of the swivel member being smaller than the second spherical end. It would have been an obvious matter of design choice to make the first spherical end smaller than the second spherical end since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Regarding claim 11, the modified Johnson device includes a first member (470) having a cavity (as introduced by the Williams, Jr. combination) and a central opening having a plurality of radiating channels (shown in Johnson, Figures 6A-6B, the channels radiating 180 degrees in each direction from the central opening); and a swivel member having a first spherical end (the spherical end introduced by the Williams, Jr. combination), the first spherical end being located within the first member's cavity.

Regarding claim 12, the swivel member of the modified Johnson device comprises a two-ended swivel member that includes an extension that can be locked into one of the plurality of radiating channels.

11. Claims 4-10 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Williams, Jr. as applied in paragraph #10 above, and further in view of Ting (6,502,794).

Regarding claim 4, Johnson in view of Williams, Jr. as applied in paragraph #10 above discloses the claimed invention, including the first spherical end of the two-ended swivel member being located within the belt clip component's cavity and the second end of the two-ended swivel member being located within the swivel base component's spherical cavity, but fails to disclose the belt clip component's cavity being spherical.

Ting, however, teaches that the spherical end (1321) of a swivel member may be rotatably held in place using a spherical cavity (211) having radiating channels (see esp. Figure 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Johnson in view of Williams, Jr. as applied in paragraph #10 above by using a spherical cavity with radiating channels, as taught by Ting, in place of the groove and release pin of Johnson, in order to provide an art-equivalent means for rotatably and removeably securing the spherical end of a swivel member to the belt clip component.

Regarding claim 5, the swivel base member of the modified Johnson device is attached directly to an electronic device carrying case, effectively satisfying the limitations of the claim.

Regarding claim 6, the initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over that disclosed by Johnson in view of Williams, Jr., and further in view of Ting, which is capable of being used in the intended manner, i.e., the two-ended swivel member being placed in a first position wherein its first and second spherical ends can rotate within their corresponding spherical cavities. There is no structure in Johnson in view of Williams, Jr., and further in view of Ting that would prohibit such functional intended use (see MPEP 2111).

Regarding claim 7, the initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over that disclosed by Johnson in view of Williams, Jr., and further in view of Ting, which is capable of being used in the intended manner, i.e., the two-ended swivel member being placed in a second position in which it is locked in place using the at least one radiating channels found in the belt clip member and the swivel base member. There is no structure in Johnson in view of Williams, Jr., and further in view of Ting that would prohibit such functional intended use (see MPEP 2111).

Regarding claim 8, the modified Johnson device has components that are made of either plastic or metal ([0276], Johnson). It would have been obvious to one having ordinary skill in the art to manufacture each of the swivel member, belt clip member, and swivel base member out of plastic, as plastic is a cheap material that is also resilient and easy to manufacture, effectively satisfying the limitations of the claim.

Regarding claim 9, the modified Johnson device comprises a belt clip (350) connected to the belt clip member, effectively satisfying the limitations of the claim.

Regarding claim 10, the Johnson device as modified with respect to Williams, Jr. provides a swivel base member which includes two channels radiating 180 degrees from one another, thus allowing the swivel member's neck to be secured in these two positions. This modified Johnson device after being further modified with respect to Ting, now includes a belt clip member that includes a plurality of channels radiating 90 degrees from one another, allowing the neck of the swivel member to be held in four positions. It would have been obvious to one having ordinary skill in the art to also provide two additional channels on the swivel base member radiating 90 degrees from the two already located thereon, in order to increase the number of positions the neck of the swivel member could be held on the swivel base member.

Regarding claim 13, Johnson in view of Williams, Jr. as applied in paragraph #10 above discloses the claimed invention except for the central opening having a plurality of radiating channels. The device of Johnson in view of Williams, Jr., and further in view of Ting includes a central opening having a plurality of radiating channels, effectively satisfying the limitations of the claim.

Regarding claim 14, the modified Johnson device includes an electronic device carrying case attached to the second member, effectively satisfying the limitations of the claim.

Regarding claim 15, the channels of the modified Johnson device are oriented 90 degrees from each other, effectively satisfying the limitations of the claim.

Regarding claim 16, the initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over that disclosed by Johnson in view of Williams, Jr., and further in view of Ting, which is capable of being used in the intended manner, i.e., the two-ended swivel member being placed in a first position which allows the first and second members to rotate. There is no structure in Johnson in view of Williams, Jr., and further in view of Ting that would prohibit such functional intended use (see MPEP 2111).

Regarding claim 17, the swivel member of the modified Johnson device includes a neck, or extension, that can be locked into one of the radiating channels found in the first member and one of the radiating channels found in the second member, effectively satisfying the limitations of the claim.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M. Larson whose telephone number is (571) 272-8649. The examiner can normally be reached on Monday - Friday, 8am - 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JML
1/20/06


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